

REMARKS

Claims 1-25 are pending.

Claims 1, 11, 13, 17 and 25 are the only independent claims.

Claims 3-10, 14-16 and 18-20 are currently amended to correct typographical informalities. These amendments have not been made for reasons related to the patentability of any claim and do not affect the scope of any claim.

Claims 25 is newly added.

The arguments contained in the Appeal Brief filed March 28, 2008 are hereby incorporated by reference in their entirety.

1. Section 102 Rejections

1A. Claims 13 and 17 – 19: Rejected under 102(b) as allegedly being anticipated by U.S. Patent Publication No. 2002/0016200 to Baerlocher et al. (“Baerlocher ‘200” hereinafter)

Claims 13 and 17-19 are patentable for at least the reasons set forth in the Appeal Brief. Specifically, Baerlocher ‘200 fails to disclose “initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls,” recited in independent claims 13 and 17 and all claims dependent therefrom.

Despite a clear and unambiguous definition of the term “handle pull” in Appellants’ specification, described in detail below, the Final Office Action argues that to use Appellants’ explicit definition of the term would improperly import limitations from the specification. This is contrary to the established rule that an applicant may be his own lexicographer, as well as the rule that claims must be

given their broadest reasonable interpretation consistent with the specification. MPEP 2173.05(a); 2111.

The Examiners' Answer alleges that the term "handle pull" has a meaning inconsistent with the use of the term in Appellants' specification. The Examiner's Answer appears to agree at page 23 that "[t]he term 'handle pull' in claims 1, 11, 13 and 17 is used by the claim to mean 'a complete primary game at a gaming device, involving the placement of a wager, the determination of an at least partially random or pseudo random outcome, the determination of a payment amount and the providing or crediting of a player with the payment amount.'" This is correct. The term is explicitly and unambiguously defined in Appellants' specification.

Despite this admission, the Examiner's Answer states, without evidence, that "the accepted meaning is 'the activation of a gaming device to produce an outcome.'" The Examiner then alleges, again without evidence, that "[t]he term is indefinite because the specification does not clearly redefine the term." This statement is demonstrably wrong for two reasons. First, if the Examiner's Answer wishes to allege that a claim limitation is indefinite, the claim in question should be rejected under 35 U.S.C. §112, second paragraph; no such rejection has ever been made with respect to this claim limitation. Second, as the Appeal Brief shows and as the Examiner's Answer admits, Appellants' specification does define the term "handle pull" at pg. 3, line 31 – pg. 4, line 2, clearly and unambiguously:

"As used herein, the term 'handle pull' refers to a complete primary game at a gaming device, involving the placement of a wager, the determination of an at least partially random or pseudo-random outcome, the determination of a payment amount, and the providing or crediting of a player with the payment amount"

(emphasis added). As explained on page 5, lines 16 – 31 of the specification as filed, a primary game is distinct from a secondary game.

Because none of the cited references contain the limitation as explicitly defined by Appellants' specification, the rejection should be withdrawn and the claims allowed.

1B. Claims 11 and 12: Rejected under 102(e) as allegedly being anticipated by U.S. Patent 6,733,389 to Webb et al. ("Webb" hereinafter)

Claims 11 and 12 are patentable for at least the reasons set forth in the Appeal Brief. Specifically, Webb fails to disclose "initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls," recited in independent claims 13 and 17 and all claims dependent therefrom.

Because none of the cited references contain the limitation as explicitly defined by Appellants' specification, the rejection should be withdrawn and the claims allowed.

1C. Claims 13 – 19: Rejected under 102(e) as allegedly being anticipated by U.S. Patent 6,602,136 to Baerlocher et al. ("Baerlocher '136" hereinafter)

Claims 13-19 are patentable for at least the reasons set forth in the Appeal Brief. Specifically, Baerlocher '136 fails to disclose "initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls," recited in independent claims 13 and 17 and all claims dependent therefrom.

Because none of the cited references contain the limitation as explicitly defined by Appellants' specification, the rejection should be withdrawn and the claims allowed.

2. Section 103 Rejections

2A. Claims 1 – 4, 8, 10 and 21: Rejected as allegedly being obvious in light of Seelig in view of Muzaffar, and further in view of U.S. Patent No. 4,700,948 to Okada (“Okada” hereinafter).

Claims 1-4, 8, 10 and 21 are patentable for at least the reasons set forth in the Appeal Brief. Appellants have argued that neither Seelig nor Muzaffar, alone or in combination, teach or suggest imposing a time penalty on a player as a result of an outcome that is determined based on a random number. The Examiner’s Answer agrees, and has now cited Okada for the disclosure of a “first outcome based on a random number generator.” Mere disclosure of a random number generator is not enough, however. The Examiner’s argument fails to cure the fundamental deficiency of the rejection.

As Appellants’ original argument noted, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP 2143.01(V). Here, it would not make sense to combine the concept of Muzaffar (i.e., imposing a time penalty on a player for a decision of the player with respect to moving along within the game) with the game of Seelig, regardless of whether a primary game result of Seelig was generated via a random number generator.

In Muzaffar, the only outcome that causes a reduction of time that is more than the time elapsed between a first time and a second time is a wrong answer by a player or a player passing on a set of images (pg. 3, second to last full paragraph), i.e, a skill-based result. Such an outcome is not an outcome determined based on a random number. Muzaffar does not contemplate reducing

an amount of time randomly, because such a random penalty would run counter to the intended purpose of the game of Muzaffar. Similarly, the only such player decisions in Seelig are decisions to place a coin into the slot machine or pull the handle of the slot machine (Col. 5, lines 16 – 29); if combined with Okada to include a randomly generated result, the player still has no decisions to make apart from inserting a coin or pulling the handle.

Time penalties in response to random outcomes are not contemplated by any of Seelig, Muzaffar or Okada, and the addition of such a penalty to any of these references, alone or in combination, would render them unsuitable for their intended purposes. Therefore, even if Okada were combined with Seelig, the combination would still not be combinable with Muzaffar in a way that meets all the limitations of the claim.

Accordingly, the rejection should be withdrawn and the claim allowed.

2B. Claims 5 – 7: Rejected as allegedly being obvious in light of Seelig in view of Muzaffar, further in view of Okada, and further in view of Walker.

Claims 5-7 are patentable for at least the reasons set forth in the Appeal Brief. Walker does not cure the deficiencies of Seelig, Muzaffar and Okada with respect to claim 1, from which claims 5-7 depend.

Accordingly, the rejection should be withdrawn and the claim allowed.

2C. Claim 9: Rejected as allegedly being obvious in light of Seelig in view of Muzaffar, further in view of Okada, and further in view of Hedrick.

Claim 9 is patentable for at least the reasons set forth in the Appeal Brief. Hedrick does not cure the deficiencies of Seelig, Muzaffar and Okada with respect to claim 1, from which claim 9 depends.

Accordingly, the rejection should be withdrawn and the claim allowed.

2D. Claim 20: Rejected as allegedly being obvious in light of Baerlocher '200 in view of Hedrick

Claim 20 is patentable for at least the reasons set forth in the Appeal Brief. Hedrick does not cure the deficiencies of Baerlocher '200 with respect to claim 17, from which claim 20 depends.

Accordingly, the rejection should be withdrawn and the claim allowed.

2E. Claim 22: Rejected as allegedly being obvious in light of Webb in view of Seelig

Claim 22 is patentable for at least the reasons set forth in the Appeal Brief. Webb does not cure the deficiencies of Seelig with respect to claim 11, from which claim 22 depends.

Accordingly, the rejection should be withdrawn and the claim allowed.

2F: Claims 23 and 24: Rejected as allegedly being obvious in light of
Baerlocher '200 in view of Seelig

Claim 9 is patentable for at least the reasons set forth in the Appeal Brief. Seelig does not cure the deficiencies of Baerlocher '200 with respect to claim 13 and 17, from which respective claims 23 and 24 depend.

Accordingly, the rejection should be withdrawn and the claim allowed.

3. Newly Added Claim 33

Claims 33 recites a method comprising, *inter alia*, “initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more complete primary games.”

Applicants respectfully request that Claim 33 be passed to issue.

CONCLUSION

Thus, for the above reasons and for the reasons set forth in Appellants' Appeal Brief, Applicants respectfully request that the rejections be withdrawn and the claims allowed.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Jerome DeLuca using the information provided below.

Please charge any fees that may be required for this paper, or credit any overpayment, to Deposit Account No. 50-0271.

November 17, 2008

Respectfully submitted,

/Jerome DeLuca, Reg. No. 55,106/
Jerome A. DeLuca, Esq.
Attorney for Appellants
Registration No. 55,106
jdeluca@walkerdigital.com
(203) 461-7319 /voice
(203) 461-7320 /fax